

REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on July 26, 2005, the Examiner rejected claims 10-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Kolling et al (United States Patent No. 5,920,847, hereinafter "Kolling"), in view of Thomson et al (United States Patent No. 4,948,174, hereinafter "Thomson"), in view of Anderson et al (United States Patent No. 6,058,380, hereinafter "Anderson"), in view of Heindel et al (United States Patent No. 6,304,857, hereinafter "Heindel"), in further view of Abe (United States Patent No. 6,501,557, hereinafter "Abe"), and rejected claims 17 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, and further in view of Ferguson et al (United States Patent No. 6,336,094, hereinafter "Ferguson").

Rejection under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected claims 10-16 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, in further view of Abe, and rejected claims 17 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Kolling, in view of Thomson, in view of Anderson, in view of Heindel, and further in view of Ferguson. Applicant respectfully submits that the claim set as provided herein is not made obvious by the cited references.

The standard for a Section 103 rejection is set for in M.P.E.P 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on

applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness according to the above-mentioned criteria. Specifically, Applicant respectfully submits that the references cited by the Examiner fail to teach or suggest all the claim limitations and that there is no motivation to modify and combine the cited references as suggested by the Examiner. To clarify this, Applicant respectfully submits the following.

In the Office Action, no mention at all is made of the following limitation to the two independent claims, claims 10 and 18: "preprocessing the transmitted payment print data at the print data reader and determining at the print data reader a manner of effectuating the payment to the vendor, wherein the preprocessing includes searching for data patterns in the transmitted payment print data." Applicant respectfully submits that since no mention is made of this limitation, there can be no *prima facie* case of obviousness established. A *prima facie* case of obviousness requires a showing that the cited references teach or suggest all claim limitations. The Examiner has not shown this. For this reason alone, the rejections should be withdrawn.

Furthermore, in the Office Action, the Examiner indicated that Kolling discloses a system configured to electronically initiate a payment of an amount owed to a vendor from a customer computer system regardless of whether the vendor utilizes an electronic payment technology (page 2). Applicant respectfully submits that the Examiner has misunderstood the teachings of Kolling. Kolling specifically and repeatedly discloses that the bill pay system of the invention is designed to work with "participating billers through a payment network" and "participating consumers." (Abstract) (See also Summary of the Invention, Col 11, lines 7-14: "participating consumers pay bills to participating billers using a bill payment network . . . for which all participants agree to a set of protocols . . . includ[ing] data exchange protocols;" Description of

the Preferred Embodiments, Col 14, lines 25-31: “participating biller[s] . . . participate in the bill pay system [and] need only deal with their bank.”) These references clearly indicate that the invention and system of Kolling is designed only to work when the vendor does utilize an electronic payment technology, not regardless of whether the vendor utilizes an electronic payment technology. (See also Col 16, lines 7-18, Col 17, lines 7-14, among others, indicating that Kolling specifically requires that the biller be a participating biller able to receive electronic payment.)

The Examiner also indicated that the “user computer system” includes “an electronic accounting application,” citing column 14, lines 36-38 (page 2). Applicant respectfully submits that this is a misreading of Kolling. Lines 36-38 clearly describe a third-party “non-bank” that “initiat[es] or receiv[es] transactions on behalf of consumers and/or billers,” and has absolutely nothing to do with “an electronic accounting application.” (Col 14, lines 33-38) Instead, it is merely a third-party entity or entities established between the biller and the payee in an electronic transaction.

While Kolling does teach an electronic bill pay order passing from the consumer to the consumer’s bank (“Bank C”) that may be computer-based in column 15 line 55 through column 16 line 6, it does not directly teach “an electronic payment file generated by and transmitted from the customer computer system to pay an amount owed to a biller,” as indicated by the Examiner (page 2). Kolling does not teach how the bill pay order is generated or transmitted, only that there is an “order delivery system” that may be “computer-based.” (Col 15 lines 62-66) In any case, Applicant respectfully submits that the Examiner has misquoted or mischaracterized Applicant’s claims in a light that makes it appear that Kolling anticipates aspects of the claims. For example, independent claims 10 and 18 require “generat[ing] the electronic payment file at

the electronic payment processing module” not merely at “the customer computer system.” Kolling does not teach a print data reader with a payment processing module (see Office Action pages 3-4), so there is no way that Kolling could disclose the claimed limitation of generating the electronic payment file at the electronic payment processing module.

In the Office Action, the Examiner indicated that Thomson discloses receiving electronic print data at a local payment processing interface from an electronic accounting application (page 5, citing Col 7, lines 1-30). First, Applicant respectfully notes that the Examiner again restates Applicant’s claims so that it appears that Thomson anticipates aspects of Applicant’s claims. Independent claims 10 and 18 require a print data reader with a check printing module and an electronic payment processing module, not merely a “local payment processing interface.” Next, Applicants respectfully submit that the Examiner has misinterpreted Thomson. Thomson does not disclose either a local payment processing interface, or an electronic accounting application. The system disclosed in Thomson is a bill printer (Col 7, lines 5-6) and a billing information database (Col 7, lines 3-30) used by the billing entity to generate bills with pre-printed checks for later use by the customer. With all due respect, a database cannot be interpreted to be “an electronic accounting application.” While such an application may make use of a database, a database and an application that uses a database are not the same thing. Also, a billing printer and a local payment processing interface (even if a payment processing interface and payment processing module on a print data reader are the same thing) are completely different items. Applicant submits that it is beyond what is envisioned by M.P.E.P 706.02(j) to make the large modifications to Thomson to arrive at the limitations on Applicant’s claims.

In the Office Action, the Examiner indicated that “it would have been obvious to one of skill in the art to include receiving electronic print data at a local electronic payment processing interface from an electronic accounting application because Thomson teaches formatting required from data files for printing purposes,” citing column 7, lines 26-27. Applicant respectfully disagrees that this is what Thomson teaches. Those lines read, “All this information is formatted and printed on the unit record under the control of the customer. . .” Applicant respectfully notes that those lines do not teach what Examiner indicates they teach. Even if Thomson teaches formatting data files for printing purposes as claimed by the Examiner, Applicant respectfully submits that this does not teach or make obvious receiving electronic print data at a local electronic payment processing module of a print data reader of the customer computer system. Applicant does not understand what one has to do with the other. Applicant again notes that the Examiner has again misstated elements of Applicant’s claims making it appear that Thomson anticipates elements of Applicant’s claims, when Thomson clearly does not.

In the Office Action, the Examiner indicated, in light of Heindel, that it would have been obvious to one of ordinary skill in the art to include using the print data to selectively generate an electronic payment file at the local electronic payment processing interface (pate 6). Applicant respectfully disagrees. Heindel specifically discloses that does not discuss the payment aspect of the billing cycle. Heindel teaches converting bill print data to an electronic bill file, but nothing in Heindel is directed at “payment processing interfaces” as the Examiner has indicated, nor does Heindel teach that print data translation for file capture allows electronic payment capability, but teaches instead that the translation allows electronic billing. Given Heindel’s specific teaching that it does not deal with payment and that the whole invention of Heindel deals with bill

presentment and not bill payment, Applicant respectfully submits that one of ordinary skill in the art would not find it obvious to apply the teachings of Heindel to make obvious aspects of Applicant's claims.

For at least the above-mentioned reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness within the meaning of M.P.E.P. 706.02(j). To further illustrate this, Applicant respectfully submits the following graphical illustration of the differences between the claimed invention and the cited references. Applicant has constructed a hypothetical claim drawing the elements from the references cited by the Examiner as they actually stand, not as misinterpreted or cited by the Examiner, but as close as the cited references will allow to the Applicant's claim. Applicant then has provided a comparison between this hypothetical claim and Applicant's submitted claim. The large number of differences indicates why Applicant's claim set herein provided is not made obvious by the combination of the cited references.

Hypothetical claim 10 compared to actual claim 10:

Hypothetical	Actual
A method for electronically initiating payment of an amount owed to a vendor from a customer computer system if the vendor is a participant in a payment network (Kolling), the method comprising: generating and transmitting billing print data (Heindel) using a third-party non-bank acting on behalf of the customer (Kolling) using a computer (Kolling) for payment of the amount owed to the vendor, if the vendor is a participant in an electronic payment network (Kolling);	A method for electronically initiating payment of an amount owed to a vendor from a customer computer system regardless of whether the vendor utilizes an electronic payment technology, the method comprising: generating and transmitting payment print data using any electronic accounting application at the customer computer system for payment of the amount owed to the vendor, regardless of whether the vendor utilizes electronic payment technology;

receiving the [payment data or billing print data] at a third-party electronic payment processing center (Kolling) electronically coupled to the customer computer (Kolling);

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if an electronic payment file is included in [the payment data or billing print data], effectuating the payment (Kolling) by performing the steps of:

using the transmitted bill print data to generate a electronic bill (Heindel);

transmitting the [electronic bill or the payment data] to a third-party electronic payment processing center for effectuating the payment of the amount owed to the vendor (Kolling); and

remitting, via the third-party electronic payment processing center, the amount to the vendor electronically where the vendor is capable of receiving electronic payment (Kolling and Anderson), and by physical delivery where the vendor is incapable of receiving electronic payment (Anderson).

receiving the transmitted payment print data at a print data reader of the customer computer system, wherein the print data reader includes a check printing module and an electronic payment processing module;

preprocessing the transmitted payment print data at the print data reader and determining at the print data reader a manner of effectuating the payment to the vendor, wherein the preprocessing includes searching for data patterns in the transmitted payment print data;

if it is determined at the print data reader that the manner of effectuating the payment includes an electronic payment file, effectuating the payment by performing the steps of:

using the transmitted payment print data to selectively generate the electronic payment file at the electronic payment processing module;

transmitting the electronic payment file from the electronic payment processing module of the customer computer system to a third-party electronic payment processing center for effectuating the payment of the amount owed to the vendor; and

remitting, via the third-party electronic payment processing center, the amount to the vendor electronically where the vendor is capable of receiving electronic payment, and by physical delivery where the vendor is incapable of receiving electronic payment.

Applicant hereby also submits a marked-up version of the above, wherein the hypothetical claim is the original, deletions are noted by strikethrough, and additions are noted by underline, highlighting the changes necessary to arrive at Applicant's claim from the combination of the cited references:

A method for electronically initiating payment of an amount owed to a vendor from a customer computer system ~~if the vendor is a participant in a payment network (Kolling);~~ regardless of whether the vendor utilizes an electronic payment technology, the method comprising:

~~generating and transmitting billing print data (Heindel)~~ payment print data using a third party non-bank acting on behalf of the customer (Kolling) any electronic accounting application at the customer computer system using a computer (Kolling) for payment of the amount owed to the vendor, ~~if the vendor is a participant in an electronic payment network (Kolling)~~ regardless of whether the vendor utilizes electronic payment technology;

~~receiving the [payment data or billing print data] at a third party electronic payment processing center (Kolling)~~ transmitted payment print data at a print data reader electronically coupled to of the customer computer (Kolling) system, wherein the print data reader includes a check printing module and an electronic payment processing module;

preprocessing the transmitted payment print data at the print data reader and determining at the print data reader a manner of effectuating the payment to the vendor, wherein the preprocessing includes searching for data patterns in the transmitted payment print data;

if it is determined at the print data reader that the manner of effectuating the payment includes an electronic payment file is included in [the payment data or billing print data], effectuating the payment (Kolling) by performing the steps of:

~~using the transmitted bill print data to generate a electronic bill (Heindel)~~ using the transmitted payment print data to selectively generate the electronic payment file at the electronic payment processing module;

transmitting the [electronic bill or the payment data] electronic payment file from the electronic payment processing module of the customer computer to a third-party electronic payment processing center for effectuating the payment of the amount owed to the vendor (Kolling); and

remitting, via the third-party electronic payment processing center, the amount to the vendor electronically where the vendor is capable of receiving electronic payment (Kolling and Anderson), and by physical delivery where the vendor is incapable of receiving electronic payment (Anderson).

Given the very large quantity of changes necessary to arrive at Applicant's claim, Applicant respectfully submits that a *prima facie* case of obviousness has not been established. Applicant further respectfully submits that independent claims 10 and 18 (which claim 18 contains a substantial number of the distinguishing limitations discussed above in reference to claim 10) provided herein are not made obvious by the combination of the cited references. Claims 11-17 and 19-21 depend on claims 10 and 18 and are at least allowable for the same reasons. Therefore, Applicant respectfully requests removal of the rejections by the Examiner.

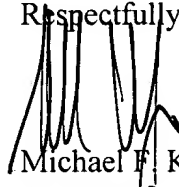
Thus, Applicant respectfully submits that for at least the reasons provided herein, the claim set as provided herein is not made obvious by the cited references and overcomes all rejections made by the Examiner in the Office Action.

CONCLUSION

Applicant submits that no new matter has been added and that the claims are now in condition for allowance. Accordingly, Applicant requests favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

DATED this 19th day of September, 2005.

Respectfully submitted,



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